REMARKS/ARGUMENTS

Claims 1-2, 4-47 and 49-50 are pending in the present application. Claims 3 and 48 were previously cancelled; by this action, claims 1, 2, 4-19, 34, and 49 are amended. Reconsideration of the claims is respectfully requested in light of the following arguments.

I. 35 U.S.C. § 103, Obviousness: Claims 1-2, 4-47 and 49-50

Claims 1-2, 4-47 and 49-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Peterson** *et al.*, System Design Method, U.S. Patent No. 6,327,551, December 4, 2001 (hereinafter "**Peterson**") in view of **Fong** *et al.*, One-Click Deployment of Data Processing Systems, U.S. Patent Publication No. 2003/0055919, March 20, 2003 (hereinafter "**Fong**"). This rejection is respectfully traversed.

The rejection states in part:

> 5. As to claim 1, Peterson teaches the invention substantially as claimed including a method for loading software onto a computer [col. 1, lines 5 – 8] , the method comprising the steps: receiving software requirements [software requirements are documented in the form of a usage requirement specification; col. 1, line 63 - col. 2, line 121 from a plurality of users [specification is an expression of the market opportunity in terms of the expected users goals, constraints imposed by users; col. 1, line 63 - col. 2, line 12] ... Peterson teaches a service packages [col. 13, lines 50 – 51] but does not teach generating a disk image containing said plurality software components configured according to said respective plurality of configuration options. However, Fong teaches deployment of data processing systems with a specific set of software under the centralized control of a graphical user interface [p. 1-2, paragraph 0013] and generating a disk image ...

Office Action dated January 26, 2006, pages 3-4.

The independent claims have now been amended to more clearly recite an embodiment of the invention. These amendments include the recitation of using software components that currently exist; this recitation provides a distinction over software components being designed. The amendments find support in the application on page 10, line 24 through page 11, line 7, which mention Freelance and WordPro, programs that are commercially available. Exemplary claim 1 as amended recites:

> 1. (Amended) A computer implemented method for creating customized disk images for loading software onto a computer, the method comprising the steps:
>
> receiving software requirements for a given computer system from a plurality of users;
>
> determining (a) a plurality of software components that currently exist and that will fulfill the software requirements while addressing constraints and affinities between said plurality of software components and (b) a respective plurality of configuration options that reflect current best practices with regard to said plurality of software components; and

generating a disk image containing said plurality of software components configured according to said respective plurality of configuration options.

The claims are not obvious over **Peterson** in view of **Fong** for at least two reasons: (a) specific features are not met, and (b) one of ordinary skill in the art would not combine these two references when they are looked at as a whole.

Features Not Met

The determination of "nonobviousness" is made after establishing the scope and content of prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1 (1966). In addition, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994).

The amendments to the *receiving* step and the *determining* step clarify that the present method is receiving *software requirements for a given computer system* and that the *software components* are components *that currently exist*. This is in contrast to **Peterson**, who is receiving requirements for a new telecommunications service and is determining software requirements that may well need to be written. **Peterson** notes:

> The invention relates to a method of designing, systems, products and services, particularly information systems used in the design of new telecommunications services, and a design engine for implementing the method.

Peterson, Column 1, lines 5-8, emphasis added

> The design method of the present invention is an analytic technique which builds on and improves the waterfall approach and uses prototyping. In the initial two steps of the design method of the present invention system feasibility and software requirements are documented in the form of a usage requirement specification. This specification is an expression of the market opportunity in terms of the expected users goals, constraints imposed by users, economic and technical factors and desired performance. The goals are decomposed and by performing a functional requirement analysis on the results from this process the main input to the preliminary design is produced, together with service states, which are states of the system allowing users to reach their goals, and service tasks, which are tasks that change the system into corresponding service states. This process is illustrated in FIG. 4.

Peterson, Column 1, line 62 through Column 2, line 11, emphasis added

Peterson is directed to a method for assisting new designs, especially in the telecommunications industry. This patent is not trying to provide provisioning of computer systems and it is submitted that the claim amendments emphasize this difference. **Peterson** does not show "*receiving software requirements for a given computer system from a plurality of users*" or "*determining (a) a plurality of software components that currently exist and that will fulfill the software requirements*" as recited in

claim 1. Further, although **Peterson** is cited to show these steps, **Fong** also does not show these steps. Therefore, the rejection is overcome.

Combination when considered as a whole

In addition to the features of the invention that are not shown by **Peterson** and **Fong**, there are considerable differences between **Peterson** and **Fong** and one of ordinary skill in the art would not seek to combine these references when they are considered as a whole.

In considering the references as a whole, one of ordinary skill in the art would look at the problems recognized and solved. **Peterson** is directed towards assisting the design of new telecommunications services, noting, "*In today's markets it is frequently necessary to produce extremely complex custom-tailored systems with great expedition. This requires the use of efficient methods for the design of systems and products*" (**Peterson**, column 2, lines 11-14). In contrast, **Fong** is directed towards the problems in the deployment of data processing systems, noting a "*major problem inhibiting deployment of a group of data processing systems is the complexity of setting up the software and parameters of a larger group of data processing systems*" (**Fong**, paragraph 0012). These two problems are unrelated and one of ordinary skill in the art would not be motivated to combine these two references when they are read a whole. Instead, one of ordinary skill in the art would look to references that discuss similar problems to the one being solved.

As further support, the two cited references provide entirely different solutions. **Peterson** provides "*an analytic technique which builds on and improves the waterfall approach and uses prototyping*" (**Peterson,** column 1, lines 63-65) and further notes that the "*present invention has a number of novel aspects which contribute to its value and which are not employed in other design processes*" (**Peterson**, column 2, lines 27-29, emphasis added). In contrast, **Fong** provides "*a method ... to facilitate the intelligent deployment of one or more data processing systems*" (**Fong**, abstract) and notes that the "*present invention provides a comprehensive method and system to facilitate the intelligent deployment of a group of data processing systems with a specific set of software, hardware firmware versions, and parameters under the centralized control of a graphical user interface*" (**Fong**, paragraph [0013]). Thus, **Peterson** is directed to a design solution, while **Fong** is directed to the deployment of software onto computers.

Thus, one of ordinary skill in the art would not be motivated to combine these two references in the manner suggested by the examiner. The references can be combined only through the improper use of hindsight with the benefit of applicants' disclosure as a template to reach the presently claimed invention.

Therefore, the rejection of claims 1-2, 4-47 and 49-50 under 35 U.S.C. § 103(a) has been overcome.

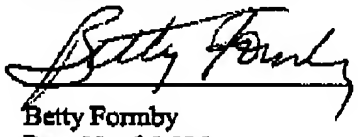
II. **Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 23, 2006

Respectfully submitted,



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